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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|--------------------------|------------------|
| 10/566,745 | 12/07/2006 | Carole Noutary | JG-ELK-5232/501100.20017 | 2260 |
| 42109 7590 05/08/2009 DUANE MORRIS LLP - NY PATENT DEPARTMENT 1540 BROADWAY NEW YORK, NY 10036-4086 | | | | |
| EXAMINER | | | | |
| LEE, DORIS L | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1796 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/566,745

Applicant(s)

NOUTARY, CAROLE

Examiner

Doris L. Lee

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The new grounds of rejection set forth below are necessitated by applicant's amendment filed on December 30, 2008. In particular, claim 14 which has been amended to clarify the scope of the claim. This combination of limitations was not present in the original claims. Thus, the following action is properly made final.
2. All outstanding objections and rejections, except for those maintained below, are withdrawn in light of applicant's amendment filed on December 30, 2008.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

Claim Rejections - 35 USC § 102

4. **Claim 14** is rejected under 35 U.S.C. 102(b) as being anticipated by **Davidson et al (US 5,994,033)**.

The rejection is adequately set forth in paragraph 4 of the Office Action mailed on April 30, 2008 and is incorporated here by reference.

Claim Rejections - 35 USC § 103

5. **Claims 1-13 and 17-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Davidson et al (US 5,994,033)** in view of **Figov (US 5,623,001)**.

The rejection is adequately set forth in paragraph 6 of the Office Action mailed on April 30, 2008 and is incorporated here by reference.

6. **Claims 14-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Davidson et al (US 5,994,033)**.

Regarding claim 14-16, Davidson teaches a polyvinyl alcohol (col. 3, line 40) with pendent photo cross-linkable groups attached thereto (col. 3, lines 41) such as acrylates (col. 3, line 40) and styryl-pyridinium groups (col. 6, lines 24).

In example 6 of Davidson, it teaches that the styryl-pyridinium is 4-(4-formylphenylethenyl)-1-methylpyridinium and the acrylate is 4-(2-acryloyloxyethoxy) benzaldehyde. However, Davidson also teaches other acrylates can be used in their invention, namely 2-acryloyloxyethyl 4-formylbenzoate (col. 16, line 63) and can replace the 4-(2-acryloyloxyethoxy) benzaldehyde (col. 17, line 49-50 and col. 8, lines 10).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to use the 2-acryloyloxyethyl 4-formylbenzoate in Example 24 in place of the 4-(2-acryloyloxyethoxy) benzaldehyde of Example 6 and arrive at the present invention. It would have amounted to nothing more than using a known acrylate in a known environment to achieved predictable results. *KSR v. Teleflex*, 550 U.S. __, 82 USPQ2d 1385 (2007).

Response to Arguments

7. Applicant's arguments filed December 30, 2008 have been fully considered but they are not persuasive.

8. **Applicant's argument:** The teaching of 4-(4-formylphenylethenyl)-1-methylpyridinium methosulfate and 4-(2-acrloyloxyethoxy) benzaldehyde are in fact derived from the combination listed and as such obviates the 102(b) rejection.

Examiner's response: *This is a logic problem that has to do with the wording of the claim. The applicant recites a claim in which the groups are "not derived from the*

*combination of A and B or C and D". Because the applicant used the word **not** and **or** in the claim, if the prior art teaches a combination of A and B, it meets the limitations of the claim because it is either (not A and B) or (not C and D), namely (not C and D), which is the case for the 102(b) rejection. It is noted that claims 14-16 are also rejected under 103(a) under different grounds which would also read on claim 14.*

9. **Applicant's argument:** Davidson teaches a stencil ink and has no applicability as an inkjet ink.

Examiner's response: *Although it is noted that screen printing inks and inkjet inks may have different viscosities, a person of ordinary skill in art at the time of the invention would have known to change the viscosity of the ink so that it would have been applicable to inkjet printing applications.*

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doris L. Lee whose telephone number is (571)270-3872. The examiner can normally be reached on Monday - Thursday 7:30 am to 5 pm and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571)272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Doris L Lee/
Examiner, Art Unit 1796

/Vasu Jagannathan/
Supervisory Patent Examiner, Art Unit 1796